Attorney Docket No.: RSW920030246US1 (7161-136U) **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Customer Number: 46320
Jeffery CHASE, et al.	:	Confirmation Number: 8866
Application No.: 10/733,659	:	Group Art Unit: 2186
Filed: December 11, 2003	:	Examiner: H. Patel

For: AUTONOMIC EVALUATION OF WEB WORKLOAD CHARACTERISTICS FOR SELF-CONFIGURATION MEMORY ALLOCATION

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated May 1, 2007.

The Examiner's response to Appellants' arguments submitted in the Appeal Brief of February 21, 2007, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejections. In response, Appellants rely upon the arguments presented in the Appeal Brief of February 21, 2007, and the arguments set forth below.

Claim 1

On pages 3-5 of the Appeal Brief, Appellants argued that PolyMix fails to identically disclose the claimed invention within the meaning of 35 U.S.C. § 102. Specifically, Appellants argued that the Examiner's statement of the rejection only addresses a "cache size" and "a trace" without any mention that the cache size is current or that the trace footprint is contemporaneously experienced. As part of these arguments, Appellants argued that the Examiner's reliance on the doctrine of inherency is misplaced. On page 5 of the Examiner's Answer, the Examiner labeled these arguments, respectively, A1 and A2.

In the first full paragraph on page 7 of the Examiner's Answer, the Examiner asserted the following:

> In response to Appellant's argument **A-1**, Examiner would like to point out to Appellant that in the PolyMix prior art, the different cache sizes (i.e. shown in the "Cache Size" column of the table shown on page 4 of 8) and associated traces (i.e. in "Unit" column in the table shown on page 4 Of 8) were current at the time when it was generated. Therefore, each of the cache sizes in the "Cache Size" column are considered current cache size while they were generated and associated traces are considered as contemporaneously experienced. Hence, the PolyMix prior art does anticipates claims 1 and 11. (bold in original) (underline added)

Claim 1, in part, recites the following:

> identifying a current cache size and a contemporaneously experienced trace footprint;
>
> determining a hit rate produced in response to said current cache size and said contemporaneously experienced trace footprint.

The absurdity of the Examiner's assertion that the cache sizes and associated traces "were current at the time when it was generated" is sufficient to identically disclose all of the above-identified features can be illustrated using the following hypothetical claim:

identifying current average home prices for 3-bedroom homes in Alexandria and contemporaneously experienced market conditions for homes, in general, in northern Virginia;

determining a selling price for a particular 3-bedroom-home in Alexandria produced in response to the current average homes prices for 3-bedroom-homes in Alexandria and contemporaneously experienced market conditions in northern Virginia.

Hypothetically, if a real estate agent suggested to a seller of a 3-bedroom home that the seller list their home for $40,000 based upon an analysis performed according to the above-identified steps, the seller would be incredulous at the real estate agent's suggestion. Upon being asked how the seller came up with the $40,000 figure, the real estate agent responded by saying that the home prices used were from a list of home prices in the 1970's but this list "were current at the time it was generated." In such a situation, Appellants respectfully submit that the seller's response would be that a real estate agent, of ordinary skill, would have recognized that the list of home prices in the 1970's, although being current at the time the list was generated, is not current today and is not appropriate for use in determining a selling price in response to current average home prices and contemporaneously experienced market conditions.

Another analogy applying the Examiner's logic involves the following hypothetical claims:

identifying a current outside temperature and contemporaneously experienced wind speed;

determining a clothing choice for a child produced in response to the current outside temperature and the contemporaneously experienced wind speed.

Appellants submit that if someone were to suggest dress a child in shorts and a t-shirt in January based upon a "current" outside temperature and contemporaneously experienced wind speed, which were current when this data was generated in July, that one skilled in the art of dressing a child would not considered the data generated in July as being "current" given the plain and ordinary meaning of the term "current."

Applying the same logic to facts of the present application, one having ordinary skill in the art would have construed the terms "current cache size" as meaning the cache size was "current" at the time the identifying step was performed. To interpret the phrase "current cache size" to mean any cache size, which was current at the time it was generated, would eviscerate any meaning from the term "current" since the Examiner could argue that all cache sizes were current at the time they were generated. Thus, in interpreting the term "current" in this manner, the Examiner has improperly construed this term by reading all meaning out of this term and in so doing, has improperly transformed the claimed "current cache size" so as to instead read "cache size."

The Examiner's "response to Appellant's argument **A-1**" also raises other factual issues. For example, the Examiner asserted "the different cache sizes … were current at the time when it was generated." In this regard, Appellants are unclear as to how more than one cache size can be considered current. The cache sizes referred to by the Examiner (and listed in the table shown on page 4 of 8 of PolyMix) range from 2.0% of working set size to 130% of working set size. Using another analogy, the Examiner's assertion is comparable to having someone responding to

the question of "what is the current temperature outside," with the answer of "the temperature outside is 2°, 2.5°, 5.0°, 10.0°, 20.0°, 50.0°, 100.0° and 130.0°."

Despite the Examiner's assertion that "associated traces are considered as contemporaneously experienced," the Examiner has still failed to establish where such a teaching is explicitly found within PolyMix or put forth an explanation as to why such a teaching is inherently taught PolyMix. Instead, the Examiner's assertions appear to lack any factual basis.

With regard to Appellants' inherency arguments, in the second full paragraph on page 7 of the Examiner's Answer, the Examiner asserted the following:

> In response to Appellant's argument **A-2**, as clearly explained in the 'Remarks' section of the Final Office Action, the "current cache size" and "contemporaneously experienced trace footprint" are inherently taught by the PolyMix prior art because they can be easily derived from (i) the table shown on page 4 of 8 of the PolyMix prior art, and/or (ii) the graph (submitted with the Final Office Action) of the PolyMix prior art. If the "current cache size" and "contemporaneously experienced trace footprint" were clearly shown in either the table or graph of PolyMix, then they were considered as explicitly instead of inherently taught by the PolyMix prior art.

At the outset, referring to page 6 of the Examiner's Examiner, Appellants note that the Examiner has mischaracterized Appellants' arguments by asserting that Appellants argued that "[t]he Examiner, however, has not establish that these features could be disclosed by PolyMix." As noted by Appellants in the paragraph spanning pages 4 and 5 of the Appeal Brief, whether or not the features could be disclosed by PolyMix is not material to the conclusion that the features are inherently disclosed. Instead, to establish inherency, the extrinsic evidence must establish that the missing element must necessarily be present in the thing described in the reference.

The Examiner's assertions in the above-reproduced paragraph, however, still fail to establish that the "current cache size" and the "contemporaneously experienced trace footprint" are necessarily present in the teachings of PolyMix. Moreover, notwithstanding the Examiner's factually-unsupported assertion that "they can be easily derived" from PolyMix, the Examiner has failed to explain why one having ordinary skill in the art would even look to derive these teachings from PolyMix since the applied prior art has not placed any importance on current cache size and a contemporaneously experienced trace footprint.

Claim 7

While responding to Appellants' arguments on page 7 of the Appeal Brief, the Examiner responded with the following in the paragraph spanning pages 7 and 8 of the Examiner's Answer:

> In response to Appellant's argument **B-1**, Examiner would like to point out to Appellant that it was so well known at the time of the current invention was made to employ the simulation model taught by the PolyMix prior art in the claimed system. Examiner should have, in the last (Final), office action, taken the Official Notice for this claimed feature to be well known in the art, however, examiner assumed that the implementation of a simulation model into a system is notoriously old in the art and did not expect to get challenged on this subject matter. (emphasis in original)

Despite the Examiner's assertion that it is "well known in the art … to employ the simulation model taught by the PolyMix prior art in the claimed system," and that the Examiner "should have … taken the Official Notice for this claimed feature," the Examiner has done nothing to correct this omission. The Examiner could have addressed this omission by either reopening prosecution or, per 37 C.F.R. § 41.39(a)(2), entering a new ground of rejection in the Examiner's Answer. The Examiner, however, chose to do neither. Thus, the Examiner has continued to fail to provide sufficient facts to support a prima facie case of obviousness.

For the reasons set forth in the Appeal Brief of February 21, 2007, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 102, 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: June 29, 2007

Respectfully submitted,

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